



3510-16-P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Patent Review and Derivation Proceedings

ACTION: Proposed collection; comment request.

SUMMARY: The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to comment on proposed and/or continuing information collections, as required by the Paperwork Reduction Act of 1995, Public Law 104–13 (44 U.S.C. 3506(c)(2)(A)).

DATES: Written comments must be submitted on or before **[INSERT DATE 60 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER]**.

ADDRESSES: Written comments may be submitted by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include “0651–0069 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.

- *Mail:* Marcie Lovett, Records Management Division Director, Office of the Chief Information Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Susan Mitchell, Lead Administrative Patent Judge, Patent Trial and Appeal Board, United States Patent and Trademark Office (USPTO), P.O. Box 1450, Alexandria, VA 22313– 1450; by telephone at 571–272–8715; or by email at susan.mitchell@uspto.gov with “0651-0069 comment” in the subject line.

Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

The USPTO is required by 35 U.S.C. 131 and 151 to examine applications and, when appropriate, issue applications as patents. The Leahy-Smith America Invents Act, which was enacted into law on September 16, 2011, provided for many changes to the procedures of the Patent Trial and Appeal Board (“PTAB” or “Board”, formerly the Board of Patent Appeals and Interference) procedures. See Public Law 112-29, 125 Stat. 284 (2011). These changes included the introduction of *inter partes* review, post-grant review, derivation proceedings, and the transitional program for covered business method patents. In 2012, six rulemaking actions were taken to propose and implement new rules of practice for the multiple reviews and proceedings impacted by the items contained within this information collection.

This renewal seeks to enable the continuation of the review and proceeding processes outlined in the information collection below. The public will use this information collection to petition the Board to initiate *inter partes* reviews, post-grant reviews, covered business method patent reviews, and derivation proceedings, as well as initiate other actions, and to ensure that the associated fees and documentation are submitted to the USPTO.

II. Method of Collection

Electronically if applicants submit the information using the Patent Review Processing System (PRPS). Applicants may be able to submit the information via e-mail if PRPS is unavailable, or by Priority Mail Express[®] if both PRPS and the Board's e-mail address are unavailable.

III. Data

OMB Number: 0651–0069.

IC Instruments and Forms: The individual instruments in this collection, as well as their associated forms, are listed in the table below.

Type of Review: Revision of a Previously Existing Information Collection

Affected Public: Businesses or other for-profit organizations; individuals or households; not-for-profit institutions; Federal Government; and state, local, or tribal governments.

Estimated Number of Respondents: The USPTO estimates that this collection will generate approximately 11,349 responses per year. Of this total, the USPTO expects that 11,274 responses will be submitted through an electronic portal such as PRPS and 75 will be submitted on paper.

Estimated Time per Response: The USPTO estimates that it will take the public an average of 128.6 hours to complete an individual form in this collection, with estimated response times for individual forms ranging between approximately 6 minutes and approximately 165 hours and 18 minutes (0.10 hours to 165.3 hours) to complete, depending on the situation and collection tool used.

The time per response, estimated annual responses, and estimated annual hour burden associated with each instrument in this information collection is shown in the table below.

Estimated Total Annual Respondent Burden Hours: 1,459,184 hours.

Estimated Total Annual Respondent (Hourly) Cost Burden: \$567,622,576. The USPTO expects that attorneys will complete the instruments associated with this information collection. The professional hourly rate for an attorney is \$389. Using this hourly rate, the USPTO estimates \$567,622,576 per year for the total hourly costs associated with respondents.

IC Number	Item	Hours (a)	Estimated Annual Responses (b)	Burden (hrs/yr) (a) x (b) = (c)	Rate (\$/hr)
1	Petition for <i>Inter Partes</i> Review	124.0	1,685	208,940	\$389.00
2	Petition for Post-Grant Review or Covered Business Method Patent Review	165.3	181	29,919.3	\$389.00
3	Petition for Derivation	165.3	3	495.9	\$389.00
4	Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review	91.6	1,109	101,584.4	\$389.00

IC Number	Item	Hours (a)	Estimated Annual Responses (b)	Burden (hrs/yr) (a) x (b) = (c)	Rate (\$/hr)
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	91.6	134	12,274.4	\$389.00
6	Request for Rehearing	80.0	272	21,760	\$389.00
7	Motions, Replies and Oppositions After Institution in <i>Inter Partes</i> Review	158.0	5,901	932,358	\$389.00
8	Motions, Replies and Oppositions After Institution in Post-Grant Review or Covered Business Method Review	148.0	665	98,420	\$389.00
9	Motions, Replies and Oppositions in Derivation Proceeding	120.0	7	840	\$389.00
10	Request for Oral Hearing	18.3	392	7,173.6	\$389.00
11	Request to Treat a Settlement as Business Confidential	2.0	397	794	\$389.00
12	Settlement	100.0	446	44,600	\$389.00
13	Arbitration Agreement and Award	4.0	2	8	\$389.00
14	Request to Make a Settlement Agreement Available	1.0	1	1	\$389.00
15	Notice of Judicial Review of a Board Decision (e.g., Notice of Appeal Under 35 U.S.C. §142)	0.1	154	15.4	\$389.00
	Totals	-----	11,349	1,459,184	-----

Estimated Total Annual (Non-hour) Respondent Cost Burden: \$60,404,425.50. There are no capital start-up or maintenance costs associated with this information collection. However, this collection does have annual (non-hour) costs in the form of filing fees and postage costs. The total annual (non-hour) costs for this collection are calculated in the accompanying tables.

Filing Fees

The IC items in this collection that contain filing fees are listed in the table below.

IC Number	Item	Responses (yr) (a)	Filing Fees (b)	Total Cost (yr) (a) x (b) = (c)
1	Petition for <i>Inter Partes</i> Review	1,685	\$31,400.00 (average)	\$52,909,000.00
2	Petition for Post-Grant Review or Covered Business Method Patent Review	181	\$41,400.00 (average)	\$7,493,400.00
3	Petition for Derivation	3	\$400.00	\$1,200.00
14	Request to Make a Settlement Agreement Available	1	\$400.00	\$400.00
	Totals	1,870	-----	\$60,404,000.00

Postage Costs

Customers may incur postage costs when submitting two of the Information Collection instruments covered by this collection to the USPTO by mail. Only the Petition for *Inter Partes* Review and the Motions, Replies, and Oppositions After Institution in *Inter Partes* Review are eligible for paper filings, and only if authorized by the PTAB. The USPTO expects that approximately 99 percent of the responses to those two items will be submitted electronically. Of the remaining 1 percent, the vast majority—98 percent—will be submitted by mail, for a total of 74 mailed submissions. The average first class USPS postage cost for a one-pound mailed submission in a flat rate envelope is \$5.75. Therefore, the USPTO estimates that the postage costs for the mailed submissions in this collection will total \$425.50.

The USPTO estimates that the total annual (non-hour) cost burden for this collection, in the form of filing fees (\$60,404,000.00) and postage costs (\$425.50), is \$60,404,425.50 per year.

IV. Request for Comments

Comments are invited on:

- (a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) ways to enhance the quality, utility, and clarity of the information to be collected; and
- (d) ways to minimize the burden of the collection of information on respondents, including through the use of automated collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they will also become a matter of public record.

Dated: June 1, 2015.

Marcie Lovett,

Records Management Division Director, USPTO,

Office of the Chief Information Officer.

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